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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,982	12/31/2001	William E. Ryan JR.	F-423	5328
919	7590	06/22/2005	EXAMINER	
PITNEY BOWES INC.			RODRIGUEZ, JOSEPH C	
35 WATERVIEW DRIVE			ART UNIT	
P.O. BOX 3000			PAPER NUMBER	
MSC 26-22			3653	
SHELTON, CT 06484-8000			DATE MAILED: 06/22/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/036,982

Applicant(s)

RYAN ET AL.

Examiner

Joseph C. Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

***Non-Final Rejection***

In view of the Remand issued by the Board of Patent Appeals and Interferences (see IFW Remand to Examiner, hereinafter "Remand", mailed 6/10/05) and the modification made to the previous 35 U.S.C. 103(a) rejection, PROSECUTION IS HEREBY REOPENED. The claims have been rejected as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The 35 U.S.C. 112 rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Here, for reasons discussed in the Remand that are hereby incorporated by reference, the claim limitation "a filtered transition area downstream of the diverter" (claim 1, In. 10 limitation added by amendment of 8/28/03) lacks proper enablement. That is, Applicant provides insufficient support for this limitation in the disclosure as it is unclear, even in light of Applicant's specification, what area referred to by the reference arrows in the figures or described by the specification is "filtered" or "sealed", or where such "filters" or "seals" would be located. Examiner requests clarification on this claim limitation and asks Applicant to clarify which of the numerous embodiments described in the specification and figures is being claimed. In particular, Examiner asks Applicant to clarify the relationship of the "filtered transition area" described in claim 1 and the "transition area" described in claim 10. Further, in the interim and for purposes of compact prosecution, Examiner has interpreted this limitation as any area containing some type of filtering system that is downstream from the diverter.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

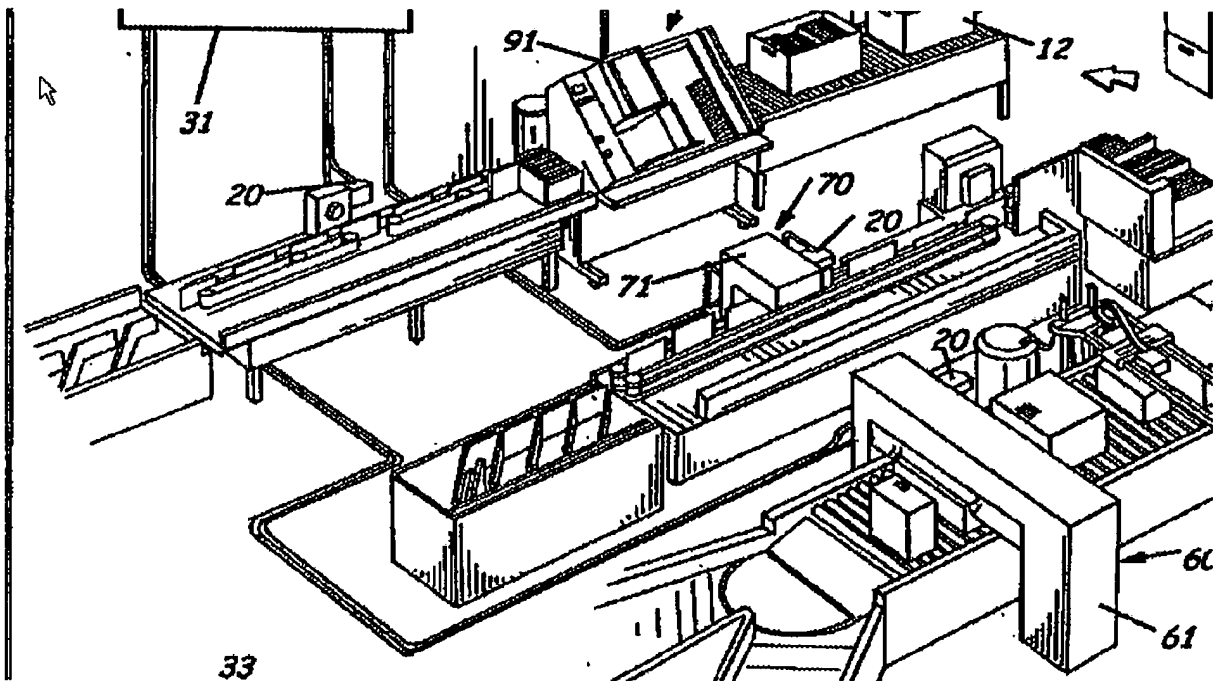
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al. ("Lopez")(US Pub. No. '099) in view of Call et al. ("Call")(US Pub. No. 2002/0124664).

Lopez teaches a system (Fig. 1-4) comprising a component for feeding and singulating (near 70, 90), a detecting module (20), a diverter (Fig. 1, box 110, 116; para. 47), a system for reading and determining (107, 108, 109, 112), and a bin module (Fig. 4, near ends of letters and flats conveyors as shown on next page), wherein Lopez teaches diverting mail to a collection module (i.e., separate container or isolation station) for further processing (Fig. 1, box 110, 116; para. 37, 47)

Regarding claim 2, the control system is regarded as inherent in the processing system taught by Lopez (processor 31; para. 47).

Regarding claims 3-9, Lopez teaches the detection module as claimed by Applicant (Fig. 4, near 20; para. 34, 44, 51). In particular, the excerpt from figure 4 included below clearly shows a first and second set of driven belts, which can also be regarded as guide walls, creating a feed path with a gap in front of the first letters and flats detection apparatus (near 20 in upper left corner).



Regarding claim 10, Lopez teaches a detection area containing a singulating component and detection module (as pictured above) as well as a collection module (not pictured but implicit from Fig. 1, box 110, 116; para. 37, 47).

Lopez as set forth above thus teaches all that is claimed except for expressly teaching a clean area for containing the bin module, wherein airflows to the detection area, and a filtered transition area downstream of the diverter. Call, however, teaches the placement of the detection area within a filtered zone that has a negative pressure region to ensure airflows to the filtered detection area (Abstract; Fig. 1, see area bounded by seals 906 and having filter 926, and negative pressure means 928; para. 0108-0116). Thus, as Call teaches the containment of the detection area within a filtered area to protect the surrounding environment from possible contamination (para.

0108) and Lopez teaches that the contaminated mail is *diverted* for further processing to an isolated area (para. 37, 47), it logically follows that downstream of the diverter clean mail will pass through the seals (906) for further processing (see fig. 1 near 911) into a clean bin module area. That is, Call teaches the placement of the detection area within a filtered zone to prevent the contaminants from spreading to other areas of the mail processing system, thus mail leaving this area can be regarded as passing a *filtered transition area* into a clean area. Consequently, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Lopez with a clean area with a filtered transition area as taught by Call to prevent the contaminants from spreading to the subsequent mail processing modules.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al. ("Lopez")(US Pub. No. '099) in view of Call et al. ("Call")(US Pub. No. '664) as applied to claims 1-11 above, and further in view of what is well known in the art as demonstrated by Lohmann (US '936) and/or Hayduchok et al. ("Hayduchok")(US '889).

Lopez in view of Call as set forth above teaches all that is claimed except under an alternative interpretation the control system and multiple bin features may not be present. These features, however, are well-known in the sorting arts. For instance, Lohmann teaches the control system for scanning envelopes (col. 2, ln. 33 et seq.). Hayduchok teaches that the scanning and then sorting of letters into multiple bins is a common processing method for postal matter (col. 7, ln. 1 et seq.). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill

in the art to modify the invention of Lopez in view of Call as taught above as these are well known processing features in the mail sorting arts and the mail is likely to require further processing after being screened for contaminants.

### ***Response to Arguments***

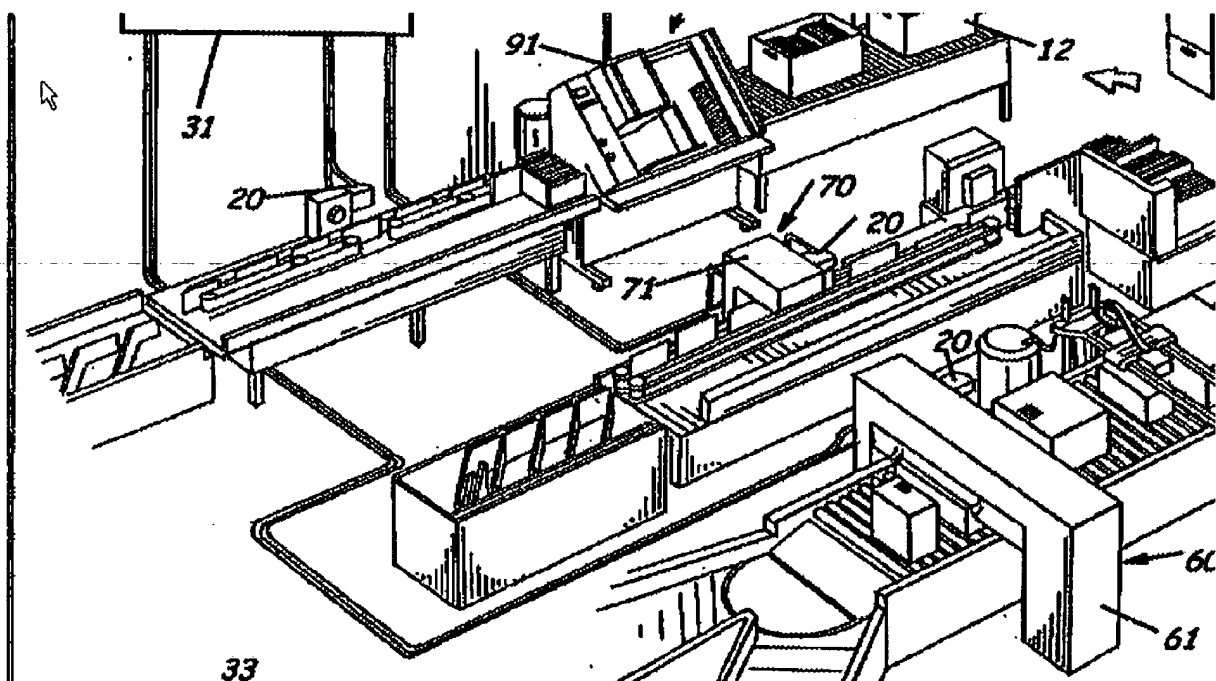
With respect to the argument that Call is not a proper reference, Examiner has supplied the prior copending U.S. provisional patent application 60/337,674 filed on Nov. 13, 2001. Figures 1 and 2 and pages 11-18 provide adequate support to establish priority.

Applicant's argument that the combination of Call and Lopez fails to teach a clean area and a filtered transition area downstream of the converter is unpersuasive upon review of the prior art. In particular, Lopez as discussed in the rejection set forth above already teaches the concept of a detection module and then routing the contaminated mail to a collection module that is isolated (See Lopez, Fig. 4, detection module 20; Fig. 1, box 110, 116; para. 37, stating that mail "can be sent to an isolation station"; para. 47, stating that the present invention also "provides for the creation of procedures 110, 116 to divert mail to bio-chem inspection procedures"). Call is merely relied on for the basic concept of surrounding the mail processing modules within a containment chamber that is filtered. Thus, it logically follows that a clean area is adjacent to these filtered areas. Therefore, it is unclear how the teachings of Call would fail to produce a filtered transition area as Call clearly teaches establishing an entire area that is filtered. Thus, almost any area within and adjacent to the containment area



suggested by Call could be regarded as a filtered transition area. Consequently, in view of the teachings of the prior art, Applicant's arguments are misplaced.

Applicant's additional argument that the combination of Call and Lopez fails to teach or suggest "determining a destination bin that is further used to expedite mail processing" is also misplaced. This limitation is not even part of claims 1 or 2 as Applicant merely claims determining a destination bin. Moreover, Lopez expressly teaches determining a destination bin (Fig. 1, near 108, 112 and Fig 4, as excerpted below, partition bins near end of letters and flats conveyors).



Therefore, the claims stand rejected.

Applicant's additional arguments that Call fails to teach screening or routing or fails to appreciate the problem of efficiently scanning for harmful materials are also misplaced. These arguments again fail to take into account the teachings of the Lopez reference that already anticipate the claim limitations regarding screening and routing

(See Lopez, Fig. 1, diagram teaching multiple contaminant detecting sensors 20 for screening and mail sorters 108, 112, 115 for routing mail). Further, it is unclear how these arguments are germane to the issue of patentability under 35 U.S.C. 103(a) as Applicant is merely arguing that the prior art fails to focus on a benefit of Appellant's claimed invention. Therefore, Applicant's arguments are again misplaced.

Applicant's additional cut-and-paste argument that the alternate rejection supplied by Examiner fails to establish a prima face obviousness rejection is also misplaced. The alternate rejection was merely supplied to demonstrate that a control system and sorting into multiple bins are well known in the mail sorting arts (Lohmann; col. 2, ln. 33 et seq.; Hayduchok, col. 7, ln. 1 et seq.). Moreover, a review of the prior art of record provides ample grounds for a prima face obviousness rejection. Therefore, Applicant's arguments are again misplaced.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

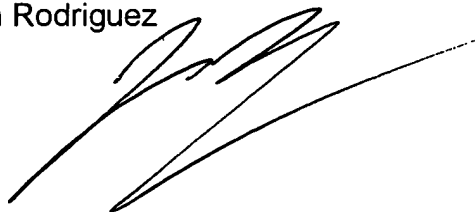
Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584**. Further, the supervisor's contact information is Donald Walsh, 571-272-6944.

Signed by Examiner Joseph Rodriguez

Jcr

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June 21, 2005

A handwritten signature in black ink, appearing to be 'J. Rodriguez', written over a horizontal line.